

REMARKS

Claim Status

Claims 26 to 36 have been examined. Claims 26, 27, 29-33 and 36 stand rejected. Claims 28, 34 and 35 stand objected to. Claims 1-25 are cancelled.

Claim List

The preliminary amendment filed in this application was not strictly compliant with 37 CFR 1.121. Applicant has amended the claim listing to comply with 37 CFR 1.121.

Claim Objections

Claims 26 and 33 stand objected to because of the following informalities:

In claim 26, "abinder" should, apparently, read "a binder." Applicant has amended the claim to correct the typographical error.

In claim 33 "terpealhydrocarbos" should, apparently, read "terpenealhydrocarbons;"; "organometalic" should, apparently, read "organometallic;"; and "nitrocallulox" should, apparently, read "nitrocellulose." Applicant has amended the claims to remove the spelling errors.

Claim Rejections - 35 USC § 112, first paragraph

Claims 26-36 stand rejected under 35 U.S.C. 112, first paragraph, because the examiner believes the specification, while being enabling for the second composition's comprising a low-viscosity commercially available glaze based on a water-soluble binder for wood sealing as an activator, does not reasonably provide enablement for the any and all activators encompassed by the language of the claim.

With regard to claim 26, the examiner states that applicant's broadest disclosure of the second composition is that it comprises a low-viscosity commercially available glaze based on a water-soluble binder for wood sealing as an activator and this does not support the any and all activators encompassed by the claim limitation reciting a second composition comprising an

activator. Possession of a species does not, necessarily, imply possession of the genus.

Applicant has amended claim 26 to reflect that the second coating composition is water based.

However, applicant respectfully disagrees with the examiner's assessment of the disclosed scope of the second coating composition. At paragraph [0015] of applicant's published application, applicant discloses that the following paragraphs [0016] and [0017] in particular, describe only an exemplary embodiment. The low-viscosity commercially available glaze based on a water-soluble binder for wood sealing described therein is disclosed as a description of a typically useful coating, viz. "This coating application of a commercially available glaze contains a small organic solvent fraction of approx 3%, a water fraction of approx. 88.50% and a solid fraction of approx. 7.5 to 8.5%." But this description is exemplary, not limiting and it is apparent that one skilled in the art would recognize that other water based compositions would be functional. Applicant has disclosed in his specification a typical second coat comprising an organic solvent, water and a dispersed solid and more precisely, has disclosed the relative quantities of each component of such second coating. Moreover, applicant has disclosed that it is essential to his process that the boundary layer between the base coat and the second coat be destroyed and that the base coat is influenced by the organic solvent in the second coat. [para. 0013]

With regard to claim 27, the examiner states that Applicant's broadest disclosure does not extend to all glazes, such as ceramic glazes. Applicant believes the meaning of the word "glaze" is modified by the context in which is used. In the context of the description set forth in paragraph [0014] the glaze is treated to "... a hot air flow for a brief period at a flow temperature of not less than 90⁰C." In this context one skilled in the art would understand the scope of the term "glazes" as not including those that are activated or dried only after high temperature firing over an extended period of time.

With regard to claim 28, the examiner states that applicant's broadest disclosure is of the exemplified wood glaze of paragraph [0017], not the any and all water-soluble acrylates encompassed by the claim limitation reciting a water-soluble acrylate. Applicant directs the

examiners attention to paragraph [0015] where applicant discloses the wood glaze of paragraph as merely an example of an embodiment of the invention. There is no technical reason supporting a limitation to the specific water soluble acrylate exemplified in paragraph [0017].

Claims 26-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 26, it is unclear to the examiner what applicant means by the composition's having a lacquer and a binder. Applicant notes that this language does not appear in claim 26, which refers to the first composition “comprising a lacquer and a binder” and applicant is unsure of the meaning of the examiner’s basis for rejection.

With regard to claim 30, the phrase “wherein the lacquer is a solvent” is indefinite. The Examiner has correctly interpreted this limitation as reciting that the lacquer contains or comprises a solvent. The claim has been amended to clarify its meaning.

With regard to claim 31, the examiner states that the phrase “over in about 5 seconds” is incomprehensible. The Examiner has correctly interpreted this limitation as reciting “for about 5 seconds.” Claim 31 has been amended to clarify the claims intended meaning.

Claim Rejections - 35 USC § 102

Claims 26, 27, 30, and 33, stand rejected under 35 U.S.C. 102(b) as being anticipated by Thacker et al. (US 2,612,456 A).

As stated by the examiner, “Thacker teaches a process for the manufacture of an ornamental crackle coating on a substrate [1:1]. The process comprises the application of a first lacquer composition on a substrate, disclosed examples including nitrocellulose and acrylic resin binders [see 2:30 ff., for example] where the process further comprises the application of a second composition that forms a transparent, vinyl copolymer organosol [see 2:30 ff., for example].”

Applicant has amended claim 26 by limiting the second composition to aqueous

compositions. Thacker does not disclose crackle coatings where the second coating is an aqueous coating.

In light of the amendment, applicant respectfully prays for favorable reconsideration of this ground for rejection.

Claim Rejections - 35 USC § 103

As stated above, Thacker discloses only non-aqueous coatings. The examiner suggests that the use of a water based second coat is used purely for environmental reasons and concludes that the substitution would have been obvious. Applicant respectfully disagrees.

Organic solvents are present in both the prior art and in applicant's system, although applicant does minimize the amounts present. But that is not the rationale specified in applicant's disclosure. Rather, applicant has discovered that the destruction of the boundary layer between the first and second coatings is crucial to the results obtained. As set forth in paragraph [0012] of applicant's published specification:

“... with a wet-in-wet coating on a first lacquer application hardening more elastically, there takes place with an arbitrary solvent a second coating with an application system hardening more inelastically, comprising a low-viscosity commercially available glaze based on a water-soluble binder for wood sealing as an activator for the initiating reaction, with brief heating of the second coating comprising a glaze application or the subjecting thereof to an air flow, whereby the boundary layer between the base coat and the second application system is destroyed by the second coating system ...” (emphasis supplied)

Thacker does not disclose the criticality of using a wet on wet system because Thacker is not aware of the importance of destroying the boundary layer between them, the solvent systems are different, inherency is not present and Thacker does not render applicant's process obvious.

Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Thacker et al. (US 2,612,456 A), as applied to claim 26 above, further in view of Inokami et al. (US 2003/0144455 A1).

As stated by the examiner, “Thacker teaches that the lacquer may contain nitrocellulose (not soluble in water) or acrylic resin dissolved in toluol [2:30 ff.]” As noted by the examiner Thacker et al. does not teach that the lacquer is water soluble.

The examiner argues that the binders disclosed by Thacker are merely exemplary. Applicant notes that nowhere does Thacker identify the listed solvent based resin systems as exemplary and even if, *arguendo*, they were, they would be exemplary of the genus of non-aqueous solvents, not the supergenus of all possible solvents.

Thacker indicates that the organic liquid medium has a slight swelling action on the resin to form an organosol [col. 1, lines 4-8]. The examiner states that any known, “suitable” binder may be utilized since it is known in the art to provide water-based formulations of acrylic resins in place of solvent based systems. Applicant respectfully disagrees.

In light of that supposed knowledge of the art, if Thacker meant to include water based systems he would have so stated or included a disclosure of at least one. But Thacker did not. This strongly suggests that Thacker meant what he disclosed, that only organic solvent based systems would be suitable. Consequently, it would not have been obvious to one skilled in the art to modify the process of Thacker so as to provide, as the acrylic resin lacquer, a water-based acrylic lacquer in place of the organic solvent-based lacquer.

As stated by the examiner, it is known in the art to provide water-based formulations of acrylic resins in place of organic solvent-based formulations for environmental reasons, citing, for example, Inokami at [0017].

That it is known to utilize water based systems in lieu of solvent based systems for environmental reasons is not controverted. But that is not the point here. Here the substitution of a water based second layer, including a small amount of solvent is utilized to disrupt the boundary layer between the first and second coat, per applicant’s specification at para. [0012]:

“... whereby the boundary layer between the base coat and the second application system is destroyed by the second coating system comprising a glaze deposited in the spraying process and, on account of the known molecular motion in the emerging mixing zone, the base coat is influenced by the solvent-containing addition of a high-boiler contained in minor quantities in the water-soluble glaze

application ...”

There is no disclosure or suggestion in either of the cited references to utilize such a composition to obtain the benefits of applicant’s invention. Applicant therefore respectfully submits that a *prima facie* case of obviousness has not been made by the examiner.

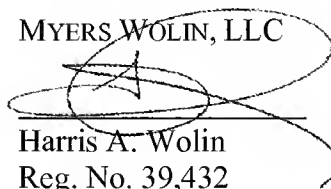
Conclusion

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants’ attorney at the telephone number indicated below.

Any fee due with this paper, not already paid through an EFS-Web filing, may be charged to Deposit Account No. 50-3894. Any overpayment may be credited to Deposit Account No. 50-3894.

Respectfully submitted,

MYERS WOLIN, LLC

A handwritten signature in black ink, appearing to read "Harris A. Wolin", is written over a horizontal line. The signature is stylized with loops and a cross-like shape in the center.

Harris A. Wolin
Reg. No. 39,432

CUSTOMER NUMBER 61650

PHONE: (973) 401-7159

FAX: (866) 864-3947